

Notice of Allowability

Application No.

10/009,567

Applicant(s)

ROFFEY ET AL.

Examiner

Art Unit

Rebecca L. Anderson

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 17 February 2005.
2. ☒ The allowed claim(s) is/are 1-8, 10, 13, 14, 24, 28 and 29, now renumbered as claims 1-14.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 053105.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

5-0-0

DETAILED ACTION

Claims 1-8, 10, 13, 14, 24, 28 and 29 are currently pending in the instant application, are allowable over the prior art of record and have been renumbered as claims 1-14

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Matthew Mulkeen on 31 May 2005.

The application has been amended as follows:

1. From the last line of claim 1: delete the comma ", " and insert in its place --or – and delete the phrase "or prodrug".
2. Delete claim 26.
3. Delete claim 30.

Response to Amendment

Applicants' amendment file 17 February 2005 amending claims 1 and 13 to include only 5-membered rings containing O or S for ring A has overcome the objection to the claims as containing non-elected subject matter as per the Decision on petition dated 30 December 2004 which states that:

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"In consequence thereof Unity is lacking between a non-heterocyclic A ring and an A ring with a N atom or an A ring with either an S or O atom (S and O being considered general equivalents)."

Therefore, the search and examination of the claims has been extended to include, along with A rings wherein A is a 5-membered ring containing one oxygen atom, A rings wherein A is a 5-membered ring containing one sulfur atom.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance. This invention relates to products of the formula (I), methods of making and methods of treating obesity. The novel and nonobvious aspect of this invention involves the nitrogen containing ring of the tricyclic ring system. The closest prior art of record, WO 9856768 (which discloses products of the formula (I) with strong affinity and selectivity for the 5-HT_{2c} receptor), fails to teach or suggest applicants instantly claimed formula (I) with the saturation as instantly claimed for the nitrogen containing heterocycle as the prior art has unsaturation in its nitrogen containing heterocycle, the nitrogen containing heterocycle is preferably pyrazole and the position equivalent to R₃ is preferably H and not alkyl.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

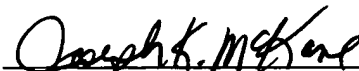
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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